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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/983,318	01/15/1998	SEPPO HUOTARI	PM244515/296	1286
909	7590	10/06/2003	EXAMINER	
PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			GESESSE, TILAHUN	
			ART UNIT	PAPER NUMBER
			2684	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/983,318

Applicant(s)

HUOTARI, SEppo

Examiner

Tilahun B Gesesse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. Drawings read in light of the specification and drawings are categorized as prior art drawings and drawings newly improved similar to specification (i.e., background of the invention and invention summary). However, the instant application fails to distinguish between drawing as prior art and drawing as main invention in order ordinary skill in the art would clearly understand improvement of the instant application. As applicant's specification indicates (page 1) that fig.1 is a drawing to illustrate the set up connection mode of background of the invention "prior art", Drawing fig.2 is to illustrate the exchange of signal between various elements of the network. Hence, there is no drawing separate illustrated drawing of the main invention or improvement of instant application.

Claim Rejections - 35 USC § 112

2. Claims 11,14,16 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The indicated claims recite, "Transmitting the identity of the calling subscriber to the switching center associated with called subscriber in connection with a request for routing information." The specification and drawings disclose signaling calling subscriber identification to home network and transmits the routing request to HLR of called subscriber home switching

center. Then the HLR transmit the roaming number request to visit home register, (page 4 lines 22-35 and figure 2). The specification does not reasonable convey to one ordinary skill in the relevant art that transmitting the identity of the calling subscriber to switch center associated with called subscriber in connection with a request for routing information. The specification does not clearly convey the transmission of CLI to called subscriber roaming switch center upon switch center routing request. Therefore, the specification does not reasonable convey to one ordinary skill in the art to how calling identification is transmitted to a called subscriber roaming switch center.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 11-12,14-16, and 18 rejected under 35 U.S.C. 102(a) as being anticipated by Serbetcioglu et al (us 5,511,111).

As to claim 11-12,14, Serbetcioglu et al disclose a method of transmitting an identity of a calling subscriber to a called subscriber, wherein the called subscriber is a mobile subscriber in a mobile communication system comprising switching centers for establishing a speech connection between the calling subscriber (336 of fig.3A) and a mobile station assigned to the called subscriber (324 of 3H), (fig3A- 3L) wherein one of the switching centers (300) is associated with the called subscriber (324 Or 376 of fig.1),

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the method comprising: Serbetcioglu et al disclose storing permanent subscriber data in a home local register and Storing temporary subscriber data in a visitor location register; (col.7 lines 19-29). It is inherent that HLR is a permanent storing database and VLR is temporary storing database. Serbetcioglu et al disclose transmitting the identity of the calling subscriber to the switching center associated with the called subscriber in connection with a request for request for routing information (col.3 lines 33-38 and fig.3A-L).

As to claim 12 and 15, Serbetcioglu et al disclose transmitting the identity of the calling subscriber to the switching center associated with the called subscriber via the home location register (HLR 352 of fig.1).

As to claim 16, Serbetcioglu et al disclose everything as explained above and furthermore Serbetcioglu et al disclose a first interface (300 of fig.3A) toward a wireless or wireline network "gateway switching center" for receiving a request a connection between a calling and a called subscribers, (fig.3A). Serbetcioglu et al disclose a second interface toward a home location register for receiving an identity of the calling subscriber in connection with a request for routing information with a request for routing information relating to called subscriber (col.7 lines 5-18 and fig.3B-3C). Serbetcioglu et al disclose a third interface toward the called subscriber for establishing the requested speech connection between the calling subscriber and the called subscriber, and for transmitting the identity of the calling subscriber obtained from the home location register to the called subscriber (fig.3H).

As to claim 18, Serbetcioglu et al disclose everything as explained above and furthermore, Serbetcioglu et al disclose the home location register (HLR 352) links MSC(VLR)320 and interfaces the wireless or wireline network 300 and calling subscriber (336) in order to access the identity or CLI (fig.3). Further more, Serbetcioglu et al disclose a second interface toward a combination of a visitor location register plus mobile switching center (320) "VMSC", for requesting routing information relating to the called subscriber and for transmitting the identity of the calling subscriber to said VMSC,(fig.3).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 13,17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serbetcioglu et al in view of Maenpad (5,600705).

As to claim 13,17 and 19, Serbetcioglu et al differs in disclosing signaling technique of subscriber identity in a map provide roaming number. Maenpaa, however, discloses signaling the subscriber identity in a map provide roaming number, (col.2 lines 1-16, col. 7 lines 60-68. It would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the map provide roaming number of Ericsson with teaching of Maenpaa, in order to identify the roaming subscriber by roaming number and locate the area roaming the subscriber.

Response to Arguments

7. Applicant's arguments filed 7/15/03 have been fully considered but they are not persuasive.

On page 1, second paragraph of response of the office action, applicant neither denies nor admits that figure 1 is prior art but simply notes that the drawings are proper.

The examiner disagrees. Applicant is required clearly to show separate in embedment the prior art of drawing being leveled as prior art and the present invention clearly illustrated to the improvement of the prior art. In this regard, applicant fails to identify which part of the drawing is prior art and which part of drawing is improvement to the prior art.

On page, fourth paragraph of response, applicant argued that Serbetcioglu et al. fails to disclose an identify of a calling subscriber to a called subscriber including transmitting the identity of the calling subscriber to the switching center associated with the called subscriber in connection with a request for routing information.

The examiner disagrees. Serbetcioglu et al disclose an identification of a calling party to called part (column 1 line 66-column 2, line 20, column 4, lines 27-32).

On page 2, second paragraph of response, applicant argued that Serbetcioglu et al fail to teach a combination of a visitor location registration plus mobile switching center.

The examiner disagrees. Applicant's argument is too detail. There is no recitation as such " a combination of a visitor location registration plus mobile switching center" in claim 16. Therefore, applicant's argument is detailed than the claim invention.

On page 2, third paragraph of response, applicant admit that Serbetcioglu et al disclose that digits of the caller's line (CLI) will be transmitted, provided CLI is present and CLI delivery to the called party is enabled (column 3, lines 34-36).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a combination of a visitor location registration plus mobile switching center) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without

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specifically pointing out how the language of the claims patentably distinguishes them from the references.

To sum up , applicant's response has been considered, however, applicant's argument has been found not persuasive. Therefore, the rejection has been maintained.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tilahun B Gesesse whose telephone number is 703-308-5873. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

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TBG

September 26, 2003


TILAHUN GESESSE
PATENT EXAMINER
